

REMARKS

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks and accompanying information, which place the application in condition for allowance.

The Examiner is thanked for indicating that claims 1-3 and 17-19 are allowed.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-31 are currently under consideration. Claims 4, 20, and 23 are amended and claims 26-31 are newly added without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

Support for the amendments to the claims can be found throughout the specification and claims as originally filed. Support for the amendment to claim 4 can be found, for example, on page 2, lines 9-12, while support for the amendment to claim 20 can be found, for instance, on page 11, line 29 – page 12, line 10. Support for the amendment to claim 23 can be found, for example, on page 24, line 2 – page 25, line 6. Finally support for new claims 26-31 can be found, for instance, on page 11, line 29 – page 12, line 10. No new matter is added.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicants are entitled. Furthermore, it is explicitly stated that these amendments should not give rise to any estoppel, as they are not narrowing.

II. REJECTIONS UNDER 35 U.S.C. § 112 ARE OVERCOME

Enablement

Claims 23-25 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. The Office Action contends that the specification, while being enabling for the inhibition of cyclooxygenase-2 for treating inflammation, does not reasonably provide enablement for “the inhibition of cyclooxygenase-2 for all diseases or disorders.”

While Applicants disagree with the rejection, in order to expedite prosecution, claim 23 is herein related to the embodiment deemed enabled by the Office Action. Consequently, Applicants assert that the rejection of claim 23, as well as the rejection of claims 24 and 25 which are dependent therefrom, is rendered moot.

Definiteness

Claim 4 was rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The Office Action suggested that formula I should be included in the claim. In response, Applicants draw attention to instant claim 4, which presents the structure for formula I. Hence, Applicants assert that the rejection of claim 4 is rendered moot.

Claims 20-22 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for not setting forth steps involved in the method/process. In response, Applicants point out that instant claim 20 relates to a method of preparing a pharmaceutical composition for selectively inhibiting cyclooxygenase-2, wherein the method comprises mixing the compound represented by formula I with pharmaceutically acceptable excipients; diluting the compound represented by formula I with pharmaceutically acceptable excipients; or encapsulating the compound represented by formula I into a carrier to form a capsule or a vesicle. Therefore, Applicants submit that claim 20, as well as claims 21 and 22 which depend therefrom, recites steps involved in the claimed method.

Accordingly, reconsideration and withdrawal of all rejections under Section 112 are requested.

III. REJECTION UNDER 35 U.S.C. § 101 IS OVERCOME

Claims 20-22 was rejected under 35 U.S.C. § 101 because the claimed recitation of a use, without setting forth any steps involved in the process, allegedly results in an improper definition of a process. In response, Applicants point out that instant claim 4 does not recite a use, but rather a method of preparing a pharmaceutical composition for selectively inhibiting cyclooxygenase-2. Thereby, the rejection of claim 20, as well as claim 21 and 22 which depend therefrom, is rendered moot.


Accordingly, reconsideration and withdrawal of all rejections under Section 101 are requested.

CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 

Ronald R. Santucci

Reg. No. 28,988

Telephone: (212) 588-0800

Facsimile: (212) 588-0500